

REMARKS

Reconsideration of the present application as amended is requested. Before turning to the merits of the second Office Action, Applicants are compelled to comment on the inappropriateness of conducting a new prior art search in connection with this application, even though Applicants did *not*: 1) submit any new prior art; or 2) change the nature of the invention for which protection is being sought.

“Moving target rejections” are those which are based on new prior art where the applicant has successfully overcome the initial rejections *without amending the claims or disclosing new prior art*. Such “moving target” rejections are contrary to USPTO policy, as set forth hereafter. They unduly delay the grant of patents and diminish their term, over-utilize USPTO resources, and burden inventors with unnecessary additional legal fees and costs. The goal of patent application examination is to fairly and expeditiously ensure that applications are proper as to form and meet all of the legal criteria for the granting of the exclusive rights being claimed. The goal should not be to see if the applicant can be pressured into giving up the quest for a patent, or forced to accept unduly narrow claims, by continually setting up new hoops for the applicant to jump through.

The FORWARD section of the MPEP indicates that it contains *instructions* to examiners “and outlines current procedures which the examiners are required or authorized to follow in appropriate cases in the normal examination of a patent application.” Indeed, this section makes it clear that the MPEP does not have the force of federal law or regulations, but nevertheless, it reflects USPTO policy which governs the administrative procedures for examination of U.S. patent applications in accordance with those laws and regulations.

According to MPEP 904.03, the examiner should conduct a comprehensive search as a prerequisite to a speedy and just determination of the issues raised by the claims of the application. MPEP 707.07(g) states that piecemeal examination should be avoided. In other

words, all appropriate objections and rejections should be made in the first Office Action. Per MPEP 707 and 37 CFR 1.104(c)(2), the examiner must cite the best prior art references in connection with the examination of the pending claims. Per MPEP 707.02, the Supervisory Primary Examiner should impress on assistants that the shortest path to a final disposition of a case is by finding the best references on a first search and carefully applying these references. A second search should not be conducted by the examiner where the applicant responds and does not change the nature of the invention for which protection is sought. Where the Applicants' response to the first Office Action does not amend the claims, does not argue any different scope of the claims, and does not cite new prior art references, the examiner should not, simply because the Applicants have overcome all outstanding rejections, conduct another search in the hopes of finding "better" prior art, or worse yet, cite different references originally found by the examiner in his or her own initial search, but not applied in the first Office Action. Where all outstanding objections as to form and rejections as to substance have been overcome by the applicant, a notice of allowance should ordinarily follow, not a new search followed by a new string of rejections.

The present application is but one more example of a disturbing USPTO trend toward moving target rejections at the same time that the backlog of applications at the USPTO continues to grow at an alarming rate.

Claim 1 has been amended to require that the hangers be *rigid*. Warman discloses a lighting fixture in the form of a chandelier with four chains that connect the supporting structure to the ceiling mount. Applicants note that the examiner contends that it would have been obvious to use double-ended hooks (set forth in Claim 10) because they are old and well known. Since the examiner might well make the same obviousness rejection with regard to amended Claim 1, pursuant to MPEP §2144.03, Applicants challenge the examiner to provide concrete evidence in the record in support of his assertion of such common knowledge. Otherwise, there is no *prima facie* case of obviousness. See *In re Zurko*, 258 F.3d at 1386, 59 USPQ 2d at 1697.

Contrary to the examiner's assertion on page 8 of the second Office Action, Applicants did not indicate that "links" are an "equivalent" to the claimed double-ended hooks. In paragraph

19 of the specification as originally filed, Applicants merely set forth examples of various alternative structure to support the means for suspending element of Claim 1 as originally filed, consistent with 35 USC §112, 6th paragraph.

The continued allowance of Claims 11-18 is noted.

Though Applicants agree with the examiner's determination of the patentability of these claims, Applicants do not specifically agree with, or acquiesce in, the examiner's paraphrasing of these claims, nor his bases for determining patentability.

Accordingly, withdrawal of the lack of novelty rejection of Claims 1, 2, 4 and 7-9 over Warman is requested.

No additional fee is due in connection with this application at this time.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Michael H. Jester", with a stylized flourish at the end.

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